PATENT   1212USA / SYMBP144US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Mauro Premutico   Examiner: Asad M. Nawaz

Serial No: 09/902,876   Art Unit: 2155

Filing Date: July 11, 2001

Title: SYSTEM AND METHOD FOR COMMUNICATING MESSAGES BETWEEN A HOST COMPUTER AND A DESIGNATED DEVICE

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Appellant's representative submits this brief in connection with an appeal of the above-identified patent application. If any additional fees are due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [SYMBP144US].

I.   Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Symbol Technologies, Inc., the assignee of the present application.

II.   Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellant, appellant's legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-44 stand rejected by the Examiner. The rejection of claims 1-44 is being appealed.

IV.   Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered after the Final Office Action.

V.   Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))

A.   Independent Claim 1

Independent claim 1 recites a method for replying to a message from a designated device in an automated messaging system, the message being sent by a sender to an address associated with a host computer, said method comprising: configuring the host computer to forward messages to an address associated with the designated device; sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer; receiving the forwarded message on the designated device; sending a reply message from the designated device to the sender, wherein the reply message includes originating information and wherein the originating information of the reply message is configured using information associated with the host computer; and sending a copy message from the designated device to the address

2

associated with the host computer, said copy message being associated with the reply message. (*See e.g.*, Fig.3; page 8, line 5 *up* through page 9, lines 1-18).

B.   Independent Claim 13

Independent claim 13 recites a method for responding to a message sent to an address associated with a host computer in an automated messaging system, the method comprising: configuring the host computer to forward messages to an address associated with a designated device; sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer; receiving the forwarded message on the designated device; sending a response message from the designated device to a recipient address, wherein the response message includes originating information and wherein the originating information of the response message is configured using information associated with the host computer and wherein the recipient address is not the address associated with the host computer; and sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the response message. (*See e.g.*, page 7, lines 10-11 and page 8, line 5 *up* through page 9, lines 1-18).

C.   Independent Claim 16

Independent claim 16 recites an automated electronic messaging system for responding to a message sent from a sender to an address associated with a host computer, the sender being associated with a sender address, the system comprising: a designated device associated with a designated device address; a message-forwarding agent for sending a forwarded message from said host computer to said designated device address, the forwarded message being associated with the message sent to the address associated with the host computer; a response message agent for sending a response message from said designated device to the sender address, wherein the response message includes originating information and wherein the originating information of the response message is configured using information associated with the host computer; and a copy agent for sending a copy message from said designated device to the address

3

associated with the host computer, said copy message being associated with the response message. (*See e.g.*, page 7, lines 10-11 and page 8, line 5 *up* through page 9, lines 1-18).

D.   Independent Claim 27

Independent claim 27 recites a method for providing a response message from a designated device in an automated messaging system, comprising: receiving on a host computer a message sent to an address associated with the host computer, the message being sent from a sender, the sender being associated with a sender address; sending a forwarded message from the host computer to an address associated with the designated device, the forwarded message being associated with the message sent to the address associated with the host computer; receiving the forwarded message on the designated device; sending a reply message from the designated device to the sender address, wherein the reply message is configured using the address associated with the host computer; sending a copy message from the designated device to the address associated with the host computer, the copy message being associated with the reply message; receiving the copy message on the host computer. (*See e.g.*, page 8, line 5 *up* through page 9, lines 1-18).

E.   Independent Claim 34

Independent claim 34 recites an automated electronic messaging system for responding to a message sent from a sender to an address associated with a host computer, the sender being associated with a sender address, said system comprising: a designated device, said designated device being associated with a designated device address; a message-formatting agent for converting the message to a reformatted message, said reformatted message can be processed by the designated device; a message-forwarding agent for sending the reformatted message from said host computer to said designated device address; and an agent for sending i) a response message from said designated device to the sender address, wherein the response message includes originating information and wherein the originating information is configured using information associated with the host computer and ii) a copy message from said designated device to the address associated with the host computer, said copy message

4

being associated with the response message. (*See e.g.*, page 8, line 5 *up* through page 9, lines 1-18).

VI.   Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A.   Claims 1-44 are unpatentable under 35 U.S.C. §102(e) as being anticipated by Horstmann *et al.* (US 6,779,022).

VII.   Argument (37 C.F.R. §41.37(c)(1)(vii))

A.   <u>Rejection of Claims 1-4, 9-19, 23-30, 34-37, and 41-44 Under 35 U.S.C. §102(e)</u>

Claims 1-4, 9-19, 23-30, 34-37, and 41-44 stand rejected under 35 U.S.C. §102(e) as being anticipated by Horstmann *et al.* (US 6,779,022). Reversal of this rejection is respectfully requested for at least the following reasons. Horstman *et al.* fails to teach or suggest each and every element of the subject claims.

i.   Horstman et al. fails to teach or suggest all elements set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Appellant's claimed invention relates to a system and method for an automated messaging system that receives messages on a host computer, which subsequently passes the message along to a designated device. As such, the user is able to receive messages and send response messages while in a location remote from the host computer. To that

5

end, independent claim 1 (and associated dependent claims) recites *sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message.* Further independent claims 13, 16, 27, and 34 (and claims that depend therefrom) recite further method and system features in accordance with the present invention. It is apparent that, in the claimed invention, *a copy message, associated with a reply message, is sent from the designated device to the host computer.* Horstmann *et al.* simply does not teach or suggest this exemplary aspect of the claimed invention.

Horstmann *et al.* relates to a mail server that collects messages from a plurality of mail servers and presents them to a user at a single location. In the Final Office Action (dated May 31, 2005), the Examiner states that Horstman *et al.* discloses the above-noted claimed aspect of the invention, citing the Fig. 4 and col. 6, lines 1-16. However, this passage of Horstman *et al.* discloses the following:

> Should the user initiate a response to either message (by selecting a reply icon 410, for example), the user's reply identifies the sender as having the email address to which the original message was directed. In the example of FIG. 4, the reply to "Alyssa@play" (to mail server 120) is identified as being from "user@play" and the reply to "Nicole@yahoo" (to a yahoo mail server 405) is identified as being from "user@home," even though both replies are from the same server. 105. Server 105 need hot be associated with any of the depicted mail servers 115, 120, or 405, but may have an entirely different path name. Alternatively, servers 115 and 120 may be "native" servers that are part of server 105. Reply icon 410 is a conventional. "button" linked to a selected one of the first and second messages.

Clearly, this passage simply discloses particular examples of a user reply message identifying the sender. It is simply not understood how anything in this passage of Horstman et al. could be construed as disclosing or suggesting *sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message.* In the most recent Advisory Action, dated August 31, 2005, the Examiner states, *"In response to Applicant's argument, Horstman et al. discloses that a copy of the original message is retained at the host and*

6

that the user can use their (sic) wireless device to forward the original message to

another device. (Abstract, col. 1 lines 47-66) Therefore, there is disclosed at the very

least the user's capability to forward/reply to any entity desired. " From this, it would

appear that the Examiner is unclear on the fact that the present issue is not about

"retaining a copy at a host" or "forwarding to a message to another device." Also, these

additional citations from the reference do not show the claimed invention. The Abstract

of Horstman *et al.* discloses:

> A mail server collects messages from a number of user accounts and presents them to the user from a single location. The user can set the mail server to block unwanted messages and to forward others to various receiving devices, including mobile telephones and pagers. Forwarded messages are automatically reformatted for the receiving device, while *a copy of the original message is retained.* The retained copy can be viewed later if the user is interested in message content that was not available to the wireless device. The user can also use the wireless device to forward the original message to another receiving device. In the case of forwarding, the saved original message and not the reformatted message is sent to the forwarding address. Some embodiments include an email agent that automatically pushes messages from intranet clients to the mail server through a firewall, thereby enabling the mail server to consolidate messages from intranet and Internet sources. (emphasis added)

Further, the passage of Horstman *et al.* at col. 1, lines 47-66 discloses:

> In addition to providing the user access to a number of mail sources, one embodiment of the invention dispatches messages to an appropriate receiving device based on the user's needs, as specified by the user. For example, a communications server in accordance with one embodiment can be configured to dispatch important messages to a wireless device, such as a mobile phone or pager.
>
> Forwarded messages are automatically reformatted for the receiving device, while *a copy of the original message is retained.* The retained copy can be viewed later if the user is interested in message content that is incompatible with the wireless device. The user can also use the wireless

7

> device to forward the original message to another receiving device. In the case of forwarding, the saved original message and not the reformatted message is sent to the forwarding address.
>
> Some conventional email services collect messages from various mail sources, allowing users to receive both messages directed to a user's work address and messages directed to a user's home address, for example. (emphasis added)

While the above passages do merely show "retaining a copy of the message," there is simply nothing in either of these passages that could be construed as disclosing or suggesting *sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message.* Therefore, it is clear from the Examiner's showing of the prior art that Horstmann *et al.* is silent with regard to this claimed limitation. However, the Advisory Action further states:

> Therefore, there is disclosed at the very least the user's capability to forward/reply to any entity desired. However, Horstman *et al.* is not silent to this fact. Horstman *et al.* further discloses that the host receives the reply message. This reply message is, therefore, associated with the reply message that was sent to the original sender. There is no further limitation in the claim as presented that recited what the host does with the reply message (i.e. stores it). (Fig. 4 and col. 6, lines 1-16). Therefore Horstman *et al.* still discloses the scope of the limitations as claimed.

It should be noted that the passage at col. 6, lines 1-16 is quoted above, and it has already been shown that this passage fails to show the limitations of the presently claimed invention. It has also been shown that Hortsman *et al.* does *not* disclose that "the host receives the reply message," as proposed by the Examiner. Also, there are no issues raised from the claims about "what the host does with the reply message," as stated by the Examiner. In summary, Horstmann *et al.* provides for relaying reply messages through the communications server without ever contemplating sending a copy of the reply message to the host computer. Therefore, it is apparent that Horstmann *et al.* does not disclose each and every aspect as claimed, as is required to show anticipation (MPEP

8

706.02). It is therefore readily apparent that the rejection of independent claims 1, 13, 16, 27, and 34 (and claims 2-4, 9-12, 14-15, 17-19, 23-26, 28-30, and 35-37 which respectively depend therefrom) should be withdrawn.

B.   **Previous Rejection of Claims 5-6, 20-21, 31-32 and 38-39 Under 35 U.S.C. §103(a)**

In the First Action of the present prosecution, claims 5-6, 20-21, 31-32 and 38-39 had been rejected under 35 U.S.C. §103(a) as being unpatentable over Horstmann *et al.* further in view of Pepe *et al.* (WO 97/33421). The subject claims respectively depend from independent claims 1, 16, 27, and 34. It is noted that these grounds of rejection were not repeated in the Final Action, though the subject claims had been indicated as rejected in the Final and in the Advisory Actions of July 7, July 25 and August 31, 2005. This lack of specific grounds of rejection is construed as a *de facto* indication of allowable subject matter in claims 5-6, 20-21, 31-32 and 38-39.

C.   **Previous Rejection of Claims 7-8, 22, 23, 33 and 40 Under 35 U.S.C. §103(a)**

In the First Action of the present prosecution, claims 7-8, 22, 23, 33, and 40 had been rejected under 35 U.S.C. §103(a) as being unpatentable over Horstmann *et al.* further in view of Lazaridis *et al.* (US 6,219,694). The subject claims respectively depend from independent claims 1, 16, 27, and 34. It is noted that these grounds of rejection were not repeated in the Final Action, though the subject claims had been indicated as rejected in the Final and in the Advisory Actions of July 7, July 25 and August 31, 2005. This lack of specific grounds of rejection is also construed as a *de facto* indication of allowable subject matter in claims 7-8, 22, 23, 33 and 40.

9

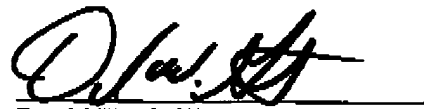09/902,876   1212USA

C.   Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-44 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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VIII.   Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1.   A method for replying to a message from a designated device in an automated messaging system, the message being sent by a sender to an address associated with a host computer, said method comprising the steps of:

    a)   configuring the host computer to forward messages to an address associated with the designated device;

    b)   sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer;

    c)   receiving the forwarded message on the designated device;

    d)   sending a reply message from the designated device to the sender, wherein the reply message includes originating information and wherein the originating information of the reply message is configured using information associated with the host computer; and

    e)   sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message.

2.   The method of claim 1 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender.

3.   The method of claim 1 wherein the forwarded message includes originating information and wherein the originating information of the forwarded message is configured using information associated with sender.

4.   The method of claim 1 wherein the message sent to the address associated with the host computer is in a first file format and wherein the forwarded message is in a

11

second file format, and wherein the method further comprises converting the first file format to the second file format.

5.   The method of claim 4 wherein the first file format is primarily a text format and wherein the second file format is primarily an audio format.

6.   The method of claim 4 wherein the first file format is primarily an audio format and wherein the second file format is primarily a text format.

7.   The method of claim 1 wherein the sending of the copy message to the address associated with the host computer is not noticeable by the sender.

8.   The method of claim 1 wherein the copy message is sent to the address associated with the host computer in a blind carbon copy format.

9.   The method of claim 1 wherein the host computer only forwards messages of a certain type to the designated device.

10.   The method of claim 1 wherein the designated device is a mobile device.

11.   The method of claim 1 wherein the message sent to the address associated with the host computer is an email message.

12.   The method of claim 1 wherein the reply message is an email message.

13.   A method for responding to a message sent to an address associated with a host computer in an automated messaging system, said method comprising the steps of:
   a)   configuring the host computer to forward messages to an address associated with a designated device;
   b)   sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being

12

associated with the message sent to the address associated with the host computer;

c) receiving the forwarded message on the designated device;

d) sending a response message from the designated device to a recipient address, wherein the response message includes originating information and wherein the originating information of the response message is configured using information associated with the host computer and wherein the recipient address is not the address associated with the host computer; and

e) sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the response message.

14. The method of claim 13 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the recipient address.

15. The method of claim 13 wherein the forwarded message includes originating information and wherein the originating information of the forwarded message is configured using information associated with sender.

16. An automated electronic messaging system for responding to a message sent from a sender to an address associated with a host computer, the sender being associated with a sender address, said system comprising:

a) a designated device, said designated device being associated with a designated device address;

b) a message-forwarding agent for sending a forwarded message from said host computer to said designated device address, said forwarded message being associated with the message sent to the address associated with the host computer;

c) a response message agent for sending a response message from said designated device to the sender address, wherein the response message

13

includes originating information and wherein the originating information of the response message is configured using information associated with the host computer; and

d)   a copy agent for sending a copy message from said designated device to the address associated with the host computer, said copy message being associated with the response message.

17.   The system of claim 16 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender.

18.   The system of claim 16 wherein the forwarded message includes originating information and wherein the originating information of the forwarded message is configured using information associated with sender.

19.   The system of claim 16 wherein the message sent to the address associated with the host computer is in a first file format and wherein the forwarded message is in a second file format, and wherein the system further comprises a formatting agent for converting the first file format to the second file format.

20.   The system of claim 19 wherein the first file format is primarily a text format and wherein the second file format is primarily an audio format.

21.   The system of claim 19 wherein the first file format is primarily an audio format and wherein the second file format is primarily a text format.

22.   The system of claim 16 wherein the sending of the copy message to the address associated with the host computer is not noticeable by the sender.

23.   The system of claim 16 wherein the host computer only forwards messages of a certain type to the designated device.

24.   The system of claim 16 wherein the designated device is a mobile device.

25.   The system of claim 16 wherein the message sent to the address associated with the host computer is an email message.

26.   The method of claim 16 wherein the response message is an email message.

27.   A method for providing a response message from a designated device in an automated messaging system, said method comprising the steps of:

    a)   receiving on a host computer a message sent to an address associated with the host computer, the message being sent from a sender, the sender being associated with a sender address;

    b)   sending a forwarded message from the host computer to an address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer;

    c)   receiving the forwarded message on the designated device;

    d)   sending a reply message from the designated device to the sender address, wherein the reply message is configured using the address associated with the host computer;

    e)   sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message;

    f)   receiving the copy message on the host computer.

28.   The method of claim 27 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender.

15

29.   The method of claim 27 wherein the forwarded message includes originating information and wherein the originating information of the forwarded message is configured using information associated with sender.

30.   The method of claim 27 wherein the message sent to the address associated with the host computer is in a first file format and wherein the forwarded message is in a second file format, and wherein the method further comprises converting the first file format to the second file format.

31.   The method of claim 30 wherein the first file format is primarily a text format and wherein the second file format is primarily an audio format.

32.   The method of claim 30 wherein the first file format is primarily an audio format and wherein the second file format is primarily a text format.

33.   The method of claim 27 wherein the sending of the copy message to the address associated with the host computer is not noticeable by the sender.

34.   An automated electronic messaging system for responding to a message sent from a sender to an address associated with a host computer, the sender being associated with a sender address, said system comprising:

  a)   a designated device, said designated device being associated with a designated device address;

  b)   a message-formatting agent for converting the message to a reformatted message, said reformatted message can be processed by the designated device;

  c)   a message-forwarding agent for sending the reformatted message from said host computer to said designated device address; and

  d)   an agent for sending i) a response message from said designated device to the sender address, wherein the response message includes originating information and wherein the originating information is configured using

16

09/902,876   1212USA

information associated with the host computer and ii) a copy message from said designated device to the address associated with the host computer, said copy message being associated with the response message.

35. The system of claim 34 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender.

36. The system of claim 34 wherein the reformatted message includes originating information and wherein the originating information of the reformatted message is configured using information associated with sender.

37. The system of claim 34 wherein the message is in a first file format and wherein the reformatted message is in a second file format, and wherein the message-formatting agent converts the first file format to the second file format.

38. The system of claim 37 wherein the first file format is primarily a text format and wherein the second file format is primarily an audio format.

39. The system of claim 37 wherein the first file format is primarily an audio format and wherein the second file format is primarily a text format.

40. The system of claim 37 wherein the sending of the copy message to the address associated with the host computer is not noticeable by the sender.

41. The system of claim 37 wherein the host computer only forwards messages of a certain type to the designated device.

42. The system of claim 37 wherein the designated device is a mobile device.

17

09/902,876   1212USA

43.   The system of claim 37 wherein the message sent to the address associated with the host computer is an email message.

44.   The method of claim 37 wherein the response message is an email message.

IX.   Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X.   Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.

18